

Appl. No. : 09/557,234
 Filed : April 24, 2000

COMMENTS

In response to the Office Action mailed March 12, 2002, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Applicant would like to thank Examiner Valenti for the courteous interview with Applicant's attorney, Glen Nuttall on July 19, 2002. This paper addresses the issues that were discussed in the interview.

Specific Changes to Claims Shown on Attached Pages.

The specific changes to the amended claims are shown on a separate set of pages attached hereto and entitled VERSION WITH MARKINGS TO SHOW CHANGES MADE, which follows the signature page of this Amendment.

Drawings Have Been Corrected

The Examiner objected to Figure 2 of the drawings because of a labeling error. Figure 2 has been corrected in the attached REQUEST FOR DRAWING CHANGES to change reference no. "22" to --20-- in order to correct this error.

All Claims Currently Are In Condition For Allowance

The Examiner rejected all of the pending claims under 35 U.S.C. §§ 102(b) and 103(a) as unpatentable over one or more of U.S. Patent No. 5,573,187 to Proctor, the Kimbrew-Walter Roses "Jet-All" sprayer, and U.S. Patent No. 3,737,105 to Arnold, taken alone or in various combinations. Claims 1-18 and 19-23 have been cancelled, and Claims 19 and 36 have been amended. Applicant respectfully contends that the pending claims define over the cited references. Specifically, Applicant contends that all of the limitations of the pending claims are not taught by the Jet-All and Proctor references if combined, and further contends that these references are not properly combinable.

As illustrated in the flyer, the Jet-All sprayer includes a handle having a downwardly-directed distal end. An "insect control head" is connected to the distal end of the handle. The head has three jets disposed thereon and is curved "to permit spraying under the leaves of miniature roses as well as the taller varieties without spray back on the user." As shown in the photographs, the water spray from the jets is directed generally upwardly and *away from the user*. When the unit is low to the ground, the water spray is nearly horizontal. Presumably, the unit is

Appl. No. : 09/557,234
 Filed : April 24, 2000

angled upwardly to spray the "taller varieties" of roses; however, the jet of water will still be directed generally upwardly and *away from the user* (see sketch).

Proctor's spraying apparatus is used to clean sewage holding tanks in recreational vehicles. It includes a rigid tube 18 that turns 90° at an elbow 32 and terminates at a spray nozzle 20. The nozzle 20 includes several openings 38 around the circumference of the nozzle and through the end of the nozzle. In use, the apparatus is placed into the holding tank before water is supplied to the nozzle. Thus, the spray from the nozzle is contained within the tank, and *water spray back onto the user is not a concern*.

Even if Combined, Jet-All and Proctor Do Not Teach the Claimed Invention

Even if the Jet-All and Proctor references are combined, they do not teach or suggest all of the limitations of Amended Claims 19 and 36 and the claims that depend therefrom. For instance, nowhere in Jet-All or Proctor is there any indication that either device would benefit from being rotated. Rotating the Jet-All device would direct the spray in the wrong direction, thus totally defeating the purpose of the specially designed "curved head". As such, *Jet-All teaches against such rotation*. Proctor only teaches moving the sprayer "up and down in the holding tank" in order to spray fluid "in all directions". Since *neither Jet-All nor Proctor even hint at the desirability of rotating their respective devices*, a combination of these references still does not suggest such rotation.

The Examiner states that "one of ordinary skill in the art would inherently rotate the apparatus to reach different parts of the plant" (page 11) Applicant respectfully disagrees. Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances *is not sufficient*." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added). Further, for a claim limitation to be inherently disclosed by a reference, "it must be necessarily present and a person of ordinary skill in the art would recognize its presence." *Crown Operations Int'l Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923 (Fed. Cir. 2002). No teaching in Jet-All or Proctor indicates 1) that a combination of the references would *necessarily* be used according to the claimed *method*; or 2) that an ordinary person would *recognize* the claimed *method*. Neither of the Jet-All or Proctor devices is used in accordance with the claimed method. Even if these references are combined, there would be no

Appl. No. : 09/557,234
 Filed : April 24, 2000

motivation to use such a combination in accordance with the claimed method unless taught to do so by Applicant's specification.

In fact, *Applicant's specification is the only reference teaching the motivation to rotate a specially-constructed spraying device in order to change its elevation.* "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein *that which only the inventor taught is used against its teacher.*" *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1984) (emphasis added).

Applicant contends that a combination of the Jet-All and Proctor references would not inherently disclose the method steps of the pending claims, and that only Applicant's specification and claims teach the claimed method. Accordingly, Applicant respectfully requests the Examiner to withdraw her rejection of the claims.

The Examiner further states that a Jet-All/Proctor combination inherently teaches "the step of holding the elongated body in a substantially horizontal attitude." (page 9) However, Applicant respectfully contends that Jet-All and Proctor each teach against such a configuration. Jet-All touts its curved head as configured to allow the device to be used "without spray back on the user." For example, and as discussed above, the Jet-All photographs show the device in use. The device is shown being drawn upwardly along a rose stalk. As the device is drawn upwardly, the user tilts the handle upwardly from, for example, the nearly horizontally spraying attitude shown in the photographs to the nearly vertically spraying attitude shown in the sketch. Thus, *Jet-All is used by continuously changing the angle of nozzle as it is drawn up a rose stalk.* The Examiner implies that Figure 1 of Proctor supports the contention that Proctor inherently teaches holding the elongate body in a substantially horizontal attitude. However, the representation in Figure 1 teaches nothing about the Proctor device's method of use. As discussed above, Proctor is used by being "moved up and down in the holding tank" so that fluid is "sprayed in all directions". Proctor, col. 2, ll. 27-30. Spraying "in all directions" would indicate that it is NOT desired to hold the nozzle 20 "in a substantially horizontal attitude" during use.

Again, only Applicant's specification and claims teach the motivation for keeping an elongate body and/or nozzle in a substantially horizontal attitude during use.

Appl. No. : 09/557,234
 Filed : April 24, 2000

Jet-All and Proctor Are Not Properly Combined

Evidence of a suggestion to combine prior art references may flow from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. However, such suggestion must be "clear and particular". See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In *Dembiczak*, the applicant claimed an orange plastic trash bag with a jack-o-lantern face printed thereon. The application was rejected as obvious in light of the combination of a prior art reference showing a plastic trash bag and a prior art reference describing a method of making a "paper bag pumpkin". The Federal Circuit reversed the finding of obviousness and held that there was no suggestion to combine the references. Even though the references "described all of the limitations of the pending claims" (*Dembiczak* at 1000), no suggestion, teaching, or motivation to combine the references was particularly identified. Thus, the combination was improper.

The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the teachings of 'Jet-All' with the teachings of Proctor. Applicant respectfully disagrees, and contends that there is no "clear and particular" teaching to combine these references. In fact, Jet-All teaches away from using the nozzle of Proctor.

References that teach away from one another cannot be properly combined to support an obviousness rejection. See *Winner Int'l Royalty Corp. v Ching-rong Wang*, 202 F.3d 1340, 1349-1350 (Fed. Cir. 2000). Jet-All teaches away from employing a nozzle as characterized by Proctor. For example, an important aspect of Jet-All is that the curved head permits "spraying under the leaves . . . without spray back on the user." (emphasis added) In fact, every photograph and the sketch on the Jet-All flyer depict the jets directed away from the user. Proctor instructs the user to insert the sprayer into the holding tank before supplying any water to the sprayer (col. 2, ll. 17-21). However, once inside the holding tank, the sprayer is configured to spray fluid "in all directions" (col. 2, ll. 28-29).

Spraying "in all directions" is totally incompatible with "without spray back on the user." The Examiner stated that the Jet-All spray nozzle "is ample distance from the user to prevent the user from getting wet." (page 11) Applicant respectfully disagrees. The Jet-All and Proctor devices are configured to be attached to a user's garden hose. Pressurized water is commonly supplied to such hoses at pressures about 80-90 psi or more. At these pressures, water

Appl. N . : 09/557,234
 Filed : April 24, 2000

from the nozzles sprays several feet. Thus, if the spray is directed "in all directions," or even if the spray is *at all* directed toward the user, the user is likely to get sprayed.

Since the Jet-All flyer teaches a focused spraying apparatus that directs spray *away from the user*, this reference teaches against combination with the Proctor nozzle, which is configured to spray "*in all directions*." Thus, these references are not properly combined.

The Examiner further states that it would be obvious to combine Jet-All with Proctor "since the distal sections of each apparatus is merely an alternate equivalent nozzle extension off of a handle and the modification is merely a change in shape/orientation to enhance the ergonomic design of the apparatus and to increase the spray coverage area for different size/shape of plants." (page 8) Applicant respectfully disagrees.

The "curved head" of Jet-All was specifically designed "to permit spraying under the leaves of . . . roses . . . without spray back on the user." This special design is tailored to the method of use of the Jet-All device, which is used by being drawn upwardly and toward the user with the 3 jets directed upwardly and outwardly at a rose stalk having leaves. As shown in the Jet-All photographs, the Jet-All device as constructed enables the user to comfortably and ergonomically hold the handle close to her body and with two hands while the curved head places the jets of water adjacent the rose stalk. Replacing the curved head with the nozzle 20 and/or elbow 32 of Proctor would not be a simple ergonomic enhancement but would *totally change the nature of the device and the way the device is used*. The Jet-All device is already ergonomic, and there is no motivation to change this ergonomic mode of use.

Simply because the cited references disclose some structure that share some aspects with Applicant's claimed method does not justify an obviousness rejection. See *In re Butler*, 1999 U.S. App. LEXIS 5056 (Fed. Cir. 1999) (unpublished). In *Butler*, the applicant claimed a method of supporting light construction products (i.e. decks) using frustum-shaped footings. A first prior art reference taught all of the recited elements except the frustum shape of the footing. A second prior art reference taught a prefabricated frustum-shaped anchor used to anchor structures to the ground. The Board of Patent Appeals and Interferences ("Board") held that the frustum-shaped anchor of the second reference is a known alternative to the shape of the footing in the first reference. See *Butler* at 6. However, the Federal Circuit *reversed the Board* and held that the second reference never *suggested* that its frustum-shaped anchor *could act in the same*

Appl. N . : 09/557,234
 Filed : April 24, 2000

manner as the recited frustum-shaped footing. See *Butler* at 6-7. Thus, the combination was inappropriate, and the claim was not obvious over the cited references.

As with the references in *Butler*, neither Jet-All nor Proctor suggests that a combination of the references *would act in the same manner* as recited in the pending claims. As such, it is not proper to combine these references. While both references disclose water sprayers, the disclosed devices employ totally different functional uses: the Jet-All device delivers a precisely-focused stream of water while placing high importance on not spraying the user; the Proctor device is configured to spray "in all directions" with no concern or provision for not spraying the user.

Since Jet-All and Proctor are not properly combined, and since these references, even if combined, do not teach all of the limitations of the pending claims, Applicant contends that all of the claims are currently in condition for allowance.

CONCLUSION


For the foregoing reasons, it is respectfully submitted that the rejections and objections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

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Dated: 9/12/02

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Appl. No. : 09/557,234
 Filed : April 24, 2000

VERSION WITH MARKINGS TO SHOW CHANGES MADE

The specific changes to the amended claims are shown on these pages. Insertions are shown underlined while deletions are ~~struck through~~.

IN THE CLAIMS:

Claims 19 and 36 have been amended as follows:

1-18. Cancelled

19. (Twice Amended) A method for removing insects from and cleaning a plant having leaves, the method comprising:

providing a hand held spraying apparatus having a handle, an elongate body portion, and a nozzle portion at a distal end of the body portion, the nozzle portion adapted to direct water flow outwardly therefrom around the circumference of the nozzle portion;

providing a source of water under pressure;

placing the spraying apparatus into communication with the source of water under pressure;

positioning the nozzle adjacent an underside of a plant leaf so that a portion of the water directed by the nozzle impacts the leaf underside and a longitudinal axis of the nozzle is generally horizontally disposed at a first elevation; and

advancing and retracting the nozzle generally horizontally so that a flow of water impacts the leaf underside along its length;

rotating the apparatus so that the longitudinal axis of the nozzle moves toward a second elevation but remains generally horizontally disposed during rotation; and

advancing and retracting the nozzle generally horizontally.

36. (Amended) A method of removing insects from and cleaning an interior portion of a leafy plant, comprising:

providing a hand held spraying apparatus having a handle, an elongate body having a length of at least about one foot, and a nozzle at a distal end of the elongate body, the nozzle configured to direct a flow of water outwardly generally around a longitudinal axis ~~the circumference~~ of the nozzle portion;

Appl. N . : 09/557,234
Filed : April 24, 2000

placing the spraying apparatus into communication with a source of water under pressure; ~~and~~

while maintaining the nozzle axis in a generally horizontal attitude, repeatedly advancing and retracting the nozzle into and out of the interior portion of the plant at a plurality of locations so that water flow is directed onto undersides of interior leaves of the plant and top sides of interior leaves of the plant; and

rotating the apparatus about the handle to change the elevation of the nozzle axis without substantially changing its generally horizontal attitude.

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